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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200223
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/137,006  
Mark: LAGUNA CANDLES

FLAME & WAX, INC.

Opposer,

v.

LAGUNA CANDLES, INC.

Applicant.

Opposition No. 91200223

**TRIAL BRIEF FOR OPPOSER**

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## TABLE OF CONTENTS

<b>I.</b>	<b>INTRODUCTION.....</b>	<b>1</b>
<b>II.</b>	<b>DESCRIPTION OF FACTUAL RECORD.....</b>	<b>1</b>
<b>A.</b>	<b>Stipulation of the Parties .....</b>	<b>1</b>
<b>B.</b>	<b>Opposer’s Evidence.....</b>	<b>1</b>
<b>C.</b>	<b>Applicant’s Evidence .....</b>	<b>2</b>
<b>III.</b>	<b>STATEMENT OF FACTS.....</b>	<b>3</b>
<b>IV.</b>	<b>ARGUMENT.....</b>	<b>4</b>
<b>A.</b>	<b>Opposer Has Standing.....</b>	<b>4</b>
<b>B.</b>	<b>Applicable Law.....</b>	<b>4</b>
<b>C.</b>	<b>Applicant’s Mark is Primarily Geographically Descriptive of the Goods.....</b>	<b>5</b>
1.	The Primary Significance of the Mark is Geographic.....	5
2.	The Mark Identifies the Geographic Origin of the Goods.....	7
3.	Purchasers are Likely to Make a Goods-Place Association / Goods-Place Association Presumed.....	9
4.	The Addition of a Generic Term Does Not Obviate the Geographical Descriptiveness Refusal under Section 2(e)(2).....	11
<b>V.</b>	<b>CONCLUSION .....</b>	<b>12</b>

## TABLE OF AUTHORITIES

### **CASES**

<i>Fram Trak Indus. v. WireTracks LLC</i> , 77 USPQ2d 2000 (TTAB2006).....	5
<i>In re Cal. Pizza Kitchen Inc.</i> , 10 USPQ2d 1704, 1706 (TTAB 1988).....	10
<i>In re Cambridge Digital Systems</i> , 1 USPQ2d 1659 (TTAB 1986).....	7, 10
<i>In re Caroline Apparel</i> , 48 USPQ2d 1542 (TTAB 1998).....	12
<i>In re Chalk’s Int’l Airlines Inc.</i> 21 USPQ2d 1637 (TTAB 1991).....	12
<i>In re Consol. Specialty Rest. Inc.</i> , 71 USPQ2d 1921 (TTAB 2004).....	5
<i>In re Fitch IBCA Inc.</i> , 64 USPQ2d 1058 (TTAB 2002).....	5
<i>In re Gregory</i> , 70 USPQ2d 1792 (TTAB 2004).....	5
<i>In re Handler Fenton Ws., Inc.</i> 214 USPQ 848 (TTAB 1982).....	8, 10
<i>In re Joint-Stock Co., “Baik”</i> , 80 USPQ2D 1305 (TTAB 2006).....	5, 7, 9
<i>In re JT Tobacconists</i> , 59 USPQ2d 1080 (TTAB 2001).....	7, 10, 12
<i>In re Loew’s Theatres, Inc.</i> , 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985).....	7, 11
<i>In re Nantucket Allserve Inc.</i> , 28 USPQ2d 1144 (TTAB 1993).....	8
<i>In re Rodale Inc.</i> , 80 USPQ2d 1696 (TTAB 2006).....	5
<i>In re Societe Generale de Eaux Minerales de Vittel S.A.</i> , 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987).....	5
<i>In re Spirits of New Merced, LLC</i> , 85 USPQ2d 1614 (TTAB 2007).....	9
<i>In re White</i> , 80 USPQ2d 1654 (TTAB 2006).....	5
<i>Warwood v. Hubbard</i> , 228 USPQ 702 (Mont. 1985).....	9

## **STATUTES**

Section 2(e)(2) of the Lanham Act, 15 U.S.C. § 1052(e)(2).....	4, 7, 8, 9, 11, 12
Rule 2.120 of the Trademark Rules of Practice, 37 C.F.R. § 2.120.....	1

## **TRADEMARK MANUAL OF EXAMING PROCEDURE**

TMEP §710.01(b).....	5
TMEP §1210.01(a).....	5
TMEP §1210.02.....	6, 12
TMEP §1210.03.....	8
TMEP §1210.04.....	10, 11

## **TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE**

TBMP §1208.03.....	5
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## **TREATISES**

J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition.....	4, 5
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## **I. INTRODUCTION**

Opposer, Flame & Wax, Inc., had no choice but to oppose the application for Applicant's purported mark, LAGUNA CANDLES, when Applicant demanded that Opposer cease all sales of its popular Maison Laguna candle line. Opposer, trading under the mark Voluspa, has worked tirelessly to build what is now a well-known and well-respected international brand from a project that the husband and wife owners started in their kitchen. With their premises just east of Laguna, Opposer has a particular interest in preventing the monopolization of a descriptive term by Applicant, especially when Applicant's clear intentions are to then attempt to use that monopoly to thwart fair competitive activity. This is exactly the sort of scenario for which the descriptiveness doctrine exists to prevent.

## **II. DESCRIPTION OF FACTUAL RECORD**

### **A. Stipulation of the Parties**

Pursuant to Rule 2.120 of the Trademark Rules of Practice, the parties stipulated to the introduction of evidence and direct testimony during trial testimony periods, filed May 4, 2012 (TTABVUE #9). The parties stipulated to the submission of direct trial testimony by declaration subject to the opposing party's right to take oral cross-examination. The stipulation also provided that all documents produced during discovery in response to document requests or interrogatories are deemed authentic business records of the producing party.

### **B. Opposer's Evidence**

Opposer submitted the following Notices of Reliance ("ONR") during its testimony period without objection by Applicant:

1. Internet Documents with Exhibit A (information on Opposer) dated November 16, 2012 (TTABVUE # 16).
2. Internet Documents with Exhibit B (Applicant's goods originate from Laguna

Beach) dated November 16, 2012 (TTABVUE # 17).

3. Internet Documents with Exhibit C (Laguna Beach is a generally known geographic place) dated November 16, 2012 (TTABVUE # 20).
4. Applicant's Discovery Responses with Exhibit D (Production of Documents) dated November 16, 2012 (TTABVUE # 21).
5. Applicant's Discovery Responses with Exhibit E (First Set of Interrogatories) dated November 16, 2012 (TTABVUE # 21).
6. Third Party Registrations with Exhibit F ("Laguna" signifies "Laguna Beach") dated November 16, 2012 (TTABVUE # 22).
7. Dictionary Definitions with Exhibits G, H & I (definitions of "Laguna Beach") dated November 16, 2012 (TTABVUE # 23).

Opposer also submitted the Rebuttal Testimony through:

8. Declaration of Troy Arntsen dated April 8, 2013 ("Arntsen Decl."), which included Exhibit A referenced therein as the Cease and Desist Letter. (TTABVUE # 38).

**C. Applicant's Evidence**

Applicant submitted Notices of Reliance ("ANR") on Documents dated January 16, 2013 (TTABVUE # 27):

1. Exhibit A (Definitions of the word "Laguna" from Webster's Dictionary);
2. Exhibit B (Definition of the word "Laguna" from www.dictionary.com);
3. Exhibit C (Definition of the word "Laguna" from www.wiktionary.com);
4. Exhibit D (information on cities named "Laguna" from www.wikipedia.com);
5. Exhibit F (list of companies in Laguna Beach from www.madeinoc.com);
6. Exhibit G (search results for "candle" among companies near Laguna Beach from

www.yellowpages.com);

7. Exhibit H (Orange County Fictitious Business Name Statements for Laguna Candles).

Applicant also submitted Notices of Reliance on Documents dated January 17, 2013 (TTABVUE # 28):

8. Exhibit I (information from the Internet Archive Wayback Machine on Applicant's website located at www.lagunacandles.com);
9. Exhibit J (Applicant's Response to First Set of Interrogatories).

### **III. STATEMENT OF FACTS**

Opposer was established in 1999. *See* Arntsen's Decl. ¶ 4 (TTABVUE # 38). Opposer's candle products are found in prestigious retailers around the world including Bloomingdales, Nordstrom, Anthropologies, Saks Fifth Avenue, regularly featured in editorial articles written for beauty, fashion, and home magazines, and a staple in the homes of Hollywood's elite. Opposer's brand has become a household name. *See* ONR, Exh. A(a) (TTABVUE # 16). In early 2010, Opposer began selling its "Maison Laguna" line of candles. *See* Arntsen Decl. ¶ 6 (TTABVUE # 38).

On September 23, 2010, Applicant applied to register LAGUNA CANDLES in connection with "candles and fragrant candles" in class 04. *See* U.S. Application Serial No. 85/137,006. Applicant's website proclaims that "Laguna Candles is a family-owned candle company located in Laguna Beach, California." ONR, Exh. B, at p. 1 (TTABVUE # 17). Applicant claims to have first used the term LAGUNA CANDLES on October 17, 2003. *See* U.S. Application Serial No. 85/137,006.

Laguna Beach, commonly known as Laguna, is an affluent coastal community in Southern California. *See* Arntsen Decl. ¶ 10 (TTABVUE # 38). It has been known for its artisan



culture since adopting its name at least as early as 1904. *See* ONR, Exh. C, at p. 1 (TTABVUE #20).

#### **IV. ARGUMENT**

##### **A. Opposer Has Standing**

Standing to oppose requires (1) a “real interest” in the proceedings and (2) a reasonable basis for [a] belief of damage. 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 20:7, at p. 20-14, (Rel. #17, 3/2001). To establish standing, an opposer need only be something more than a gratuitous interloper or vicarious avenger of someone’s rights. 3 MCCARTHY ON TRADEMARKS, § 20:7, at p. 20-16. Here, Opposer has used and is using the term “Maison Laguna” to identify one of its product lines, and intends to continue such use. Applicant has threatened to sue Opposer for use of the term “Maison Laguna” in connection with Opposer’s candles. *See* Arntsen Decl., Exh. A (TTABVUE # 38). Accordingly, Opposer could be damaged by registration of the term LAGUNA CANDLES by Applicant. *See* Arntsen Decl. ¶ 7 (TTABVUE # 38). Such registration could impair Opposer’s right to use the term LAGUNA, and therefore, Opposer has standing to oppose.

##### **B. Applicable Law**

A three-part test is applied to determine whether a mark is primarily geographically descriptive of the goods and/or services within the meaning of Trademark Act Section 2(e)(2):

- (1) The primary significance of the mark is a generally known geographic place or location;
- (2) The goods and/or services for which applicant seeks registration originate in the geographic place identified in the mark; and
- (3) Purchasers would be likely to make a goods-place or services-place association; that is, purchasers would be likely to believe that the goods and/or services

originate in the geographic place identified in the mark. *See* TMEP §1210.01(a); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Joint-Stock Co. “Baik,”* 80 USPQ2d 1305, 1309 (TTAB 2006).

Note that some of the materials relied upon to support Applicant’s arguments were obtained from the Internet. Material obtained from the Internet is generally accepted as competent evidence in examination and ex parte proceedings. *See In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (Internet evidence accepted by the Board to show genericness); *In re White*, 80 USPQ2d 1654, 1662 (TTAB 2006). (Internet evidence accepted by the Board to show false connection); *In re Joint-Stock Co. “Baik”*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (Internet evidence accepted by the Board to show geographic significance); *Fram Trak Indus. v. WireTracks LLC*, 77 USPQ2d 2000, 2006 (TTAB 2006) (Internet evidence accepted by the Board to show relatedness of goods); *In re Consol. Specialty Rest. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (Internet evidence accepted by the Board to show that geographic location is well-known for particular goods); *In re Gregory*, 70 USPQ2d 1792, 1793 (TTAB 2004) (Internet evidence accepted by the Board to show surname significance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002) (Internet evidence accepted by the Board to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

**C. Applicant’s Mark is Primarily Geographically Descriptive of the Goods.**

**1. The Primary Significance of the Mark is Geographic**

A mark is primarily geographically descriptive if it identifies a significant geographic location, and the primary meaning of the mark is the geographic meaning. *See* TMEP § 1210.02. Furthermore, shorthand or nickname references to geographical places, such as Laguna, are subject to the same standard. *See* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND

UNFAIR COMPETITION §14:3 at 14-17, n.12 (Rel. #40, 12/2006) (internal citations omitted). With respect to the first prong of the test, the undisputed evidence shows that Laguna Beach, commonly known as Laguna, is a coastal community in Southern California well known for its artisan and resort-like culture. *See* ONR, Exh. C (TTABVUE # 20). This evidence further demonstrates that Laguna is home to a community of artisans, including Applicant. *See* Applicant's Answer to Notice of Opposition ¶ 7. In fact, the popularity of Laguna's world renowned Sawdust Art Festival has inspired year-round classes for candle making. *See* ONR, Exh. C, at p. 77, section (t) (TTABVUE # 20).

It is anticipated that Applicant will argue that using the term "Laguna" versus "Laguna Beach" somehow alters its primary significance into something other than a geographical location. But Applicant's very own dictionary printout for the definition of "laguna" poses "Relevant Questions: Where is Laguna Beach?" and "How to Dress in Laguna Beach?" *See* ANR, Exh. B [www.dictionary.com](http://www.dictionary.com) (TTABVUE # 27).

In recent decades neighboring communities such as Laguna Hills, Laguna Niguel and Laguna Woods, have all cropped up which play off of the notoriety of Laguna Beach. Applicant, in its evidence, references such other Laguna locations presumably in an attempt to argue that Laguna referenced on its own without the inclusion of the term "Beach" may not hold the requisite geographical significance. *See* ANR, Exh. A-D, (TTABVUE #27). However, that is simply not the case. The fact is that the artisan beach community of Laguna Beach continues to dominate any reference to the term Laguna. So regardless of whether one uses the term Laguna or Laguna Beach, it is apparent that its primary significance is that of a city or, in other words a geographical location.

Furthermore, the fact that the mark identifies more than one geographic location does not necessarily detract from the term's primary geographic significance. *See, e.g., In re Loew's*

*Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (DURANGO held primarily geographically deceptively misdescriptive of chewing tobacco not grown in Durango, Mexico, where the evidence of record showed that tobacco is a crop produced and marketed in that area, even though there is more than one place named Durango); *In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1662 (TTAB 1986) (CAMBRIDGE DIGITAL and design held primarily geographically descriptive of computer systems and parts thereof, where applicant's place of business is Cambridge, Massachusetts, even though there is more than one Cambridge).

Since the primary significance of the term Laguna is a generally known geographic place, the first prong of the test for determining geographical descriptiveness under Section 2(e)(2) of the Trademark Act has been met.

## **2. The Mark Identifies the Geographic Origin of the Goods**

For goods to originate in a geographic place, the record must show that they are either manufactured, packaged and shipped from there, or they contain a main ingredient or component derived from there. *See In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305 (TTAB 2006) (holding applicant's vodka originates in the place named in the mark because it is made from the water of the place named in the mark and applicant produces various vodkas from a location near the place named in the mark); *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (holding applicant's goods originate in the place named in the mark because they are packaged and shipped from the place named in the mark, and applicant's business is also located in such place); *In re Nantucket Allserve, Inc.*, 28 USPQ2d 1144 (TTAB 1993) (holding applicant's beverages originate in the place named in the mark because labels for applicant's goods suggest a connection with the geographic location named in the mark, additional evidence suggests that some ingredients come from the place named in the mark and that applicant's goods are sold at applicant's store located in the place named in the mark, and applicant's corporate headquarters

and research and development center are located in the place named in the mark); *In re Handler Fenton Ws., Inc.*, 214 USPQ 848 (TTAB 1982); TMEP §1210.03.

Applicant's website indicates that the business is located in Laguna Beach. ONR, Exh. B, at p. 1 (TTABVUE # 17). Applicant's invoices further include their Laguna address as the point of origin of the goods. *See* ONR, Exh. D, Applicant's document bates stamp LAGUNA5245, LAGUNA5246, LAGUNA5248 (TTABVUE # 21). Moreover, local press garnered by Applicant refers to Applicant as a "Laguna company." *See* ONR, Exh. D, Applicant's document bates stamp LAGUNA5207 (TTABVUE # 21). It is unclear if all of the product components originate in Laguna but it is fair to say that the goods originate there and Applicant, trading on the cache of Laguna, represents such in their public facing materials.

Moreover, the Applicant is likely to argue that the proposed mark is not geographically descriptive under §2(e)(2) of the Trademark Act because the term LAGUNA does not identify the place from which applicant's products "originate," but merely identifies the location of the Applicant's office. However, the Applicant has indicated that its products are actually sold and shipped from their Laguna Beach location. It is only the raw materials are supplied from source outside Laguna Beach, namely one supplier in Ohio and two suppliers from elsewhere in Southern California. In fact, one is in Los Angeles and the another is in North Hollywood. *See* ANR, Exh. J, response to Interrogatory No. 8 (TTABVUE # 28); *See* ONR, Exh. D, Applicant's document bates stamp LAGUNA5201 (TTABVUE # 21). So two of the three suppliers for Applicant's raw materials are located in neighboring Los Angeles county, about a one hour car ride from Applicant's location in Laguna Beach, California. A product that is produced near the geographic place named in the applied-for mark is sufficient to support a finding that the goods originate in that geographic location. *See, e.g., In re Spirits of New Merced, LLC*, 85 USPQ2d 1614, 1621 (TTAB 2007) (holding YOSEMITE BEER primarily geographically descriptive of

beer produced and sold in Merced, California, a city located 80 miles from Yosemite National Park, where the goods originated in an area “located near YOSEMITE”); *In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305, 1310-11 (TTAB 2006) (holding BAIKALSKAYA, the Russian equivalent of “from Baikal” or “Baikal’s,” primarily geographically descriptive of vodka where applicant was located near Lake Baikal, and applicant did not dispute that it produced vodka from a location near and used water from Lake Baikal); *see also Warwood v. Hubbard*, 228 USPQ 702, 702-03 (Mont. 1985) (holding YELLOWSTONE OUTFITTERS primarily geographically descriptive of outfitting services offered “near Yellowstone Park”).

Taking into account the totality of the foregoing, the second prong of the test for determining geographical descriptiveness under Section 2(e)(2) of the Trademark Act has been met.

### **3. Purchasers are Likely to Make a Goods-Place Association/Goods-Place Association Presumed**

When there is no genuine issue that the geographical significance of a term is its primary significance, and the geographical place is neither obscure nor remote, a public association of the goods with the place is presumed if an applicant’s goods originate in the place named in the mark. TMEP §1210.04; *see, e.g., In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 (TTAB 1988) (holding CALIFORNIA PIZZA KITCHEN primarily geographically descriptive of restaurant services rendered in California); *In re Handler Fenton Ws., Inc.*, 214 USPQ 848, 849-50 (TTAB 1982) (holding DENVER WESTERNS primarily geographically descriptive of western-style shirts originating in Denver). Opposer has already established that the primary significance of Laguna is geographic and that Applicant’s goods originate in Laguna and thus it should be presumed that purchasers will make a goods-place association. Nevertheless, Applicant may argue that its goods do not “originate” in Laguna Beach, California and that a

presumption should not be made that its goods would be associated with Laguna Beach, California.

Assuming *arguendo* that a goods-place association was not presumed, Opposer can easily establish that one exists. To support a goods-place association, the evidence need only show a “reasonable basis” for concluding that the public is likely to believe that the mark identifies the place from which the goods originate. See *In re JT Tobacconists*, 59 USPQ2d 1080, 1083-84 (TTAB 2001) (finding that nothing in the record suggested that it would be incongruous or unexpected for the purchasing public to believe that applicant’s cigars, cigar cases and humidors, “manufactured products which could have their origin practically anywhere,” came from the place named in the mark, as applicant was located in the place and the goods were packaged and shipped from the location, such that consumers would have a reasonable basis to believe the goods came from the place named in the mark); *In re Cambridge Digital Sys.*, 1 USPQ2d 1659, 1661-62 (TTAB 1986) (finding that the location named in the mark was renowned for educational institutions and the record demonstrated the location was a manufacturing and commercial center producing related goods such that purchasers of applicant’s goods would reasonably believe they emanate from the place named in the mark); see also TMEP §1210.04; cf. *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 767-68, 226 USPQ 865, 867-68 (Fed. Cir. 1985). Applicant’s own website displayed a tagline of “Not just a candle, but a lifestyle.” See ANR, Exh. I, part 1 at p. 2 (TTABVUE # 28). It’s the Laguna Beach “lifestyle” which Applicant is attempting to associate with, capitalize on and, by way of its registration, unfairly monopolize. Applicant’s Internet blog encourages consumers to “Take home the memory of Laguna Beach with our Coastal Collection.” See ONR, Exh. B, at p. 12 (TTABVUE # 17). Again, Applicant seeks to instill in the mind of consumers that their candles are entwined with Laguna and originate therefrom. Applicant actively promotes a goods-place association at every opportunity

by holding itself out as a purveyor of artisan goods within the Laguna Beach community. *See* ONR, Exh. D, Applicant's document bates stamp LAGUNA5198 (TTABVUE # 21).

While a goods-place association can be evidenced if not presumed, Opposer is confident it can be presumed. There is no question that Laguna signifies Laguna Beach, CA, a well-known artisan community and vacation destination. Applicant's goods originate in Laguna. Furthermore, when there is no genuine issue that the geographical significance of a term is its primary significance, and the geographical place is neither obscure nor remote, it is reasonable to conclude that the public is likely to associate the goods with the place named in the mark. Thus, the third prong of the test for determining geographical descriptiveness under Section 2(e)(2) of the Trademark Act has been met.

**4. The Addition of a Generic Term Does Not Obviate the Geographic Descriptiveness Refusal under Section 2(e)(2)**

The Applicant has added the generic word "candles" to the term "laguna" in its mark. The term "candles" clearly identifies the generic term for Applicant's goods which are candles. *See* U.S. Application Serial No. 85/137,006. The addition of a generic word to a geographic word or term does not diminish that geographic word or term's primary geographic significance. *See* TMEP §1210.02(c)(ii); *See, e.g., In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (holding MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (holding CAROLINA APPAREL primarily geographically descriptive of retail clothing store services); *In re Chalk's Int'l Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (holding PARADISE ISLAND AIRLINES primarily geographically descriptive of the transportation of passengers and goods by air). Adding the generic term "candles" to the generally known geographic term "Laguna" does nothing to obviate the descriptiveness of Applicant's mark.



## V. CONCLUSION

The foregoing has demonstrated that: (a) the primary significance of LAGUNA is geographic; (b) the mark identifies the geographic origin of the Applicant's goods; and (c) prospective purchasers are likely to think that Applicant's products originate in the geographic place named in the mark. As such, the mark has been shown to be primarily geographically descriptive of the origin of the applicant's goods. Accordingly, the Opposer contends that the refusal to register the mark under Section 2(e)(2) of the Trademark Act, 15 U.S.C. Section 1052(e)(2) is proper.

Dated: June 10, 2013

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I certify that on June 10, 2013, I served a copy of the above **OPPOSER'S TRIAL BRIEF** to the  
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